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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/963,333	09/24/2001	Vincent P. Stanton JR.	11926-015002	9730

7590

03/04/2002

ANITA L. MEIKLEJOHN, PH.D.  
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Boston, MA 02110-2804

EXAMINER

CHAKRABARTI, ARUN K

ART UNIT

PAPER NUMBER

1634

DATE MAILED: 03/04/2002

6

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/963,333

Applicant(s)

Stanton

Examiner

Arun Chakrabarti

Art Unit

1655

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1) ☒ Responsive to communication(s) filed on 9/24/01, 10/30/01, 1/16/02, and 1/17/02

2a) ☐ This action is FINAL.

2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

4) ☒ Claim(s) 1-49 is/are pending in the application.

4a) Of the above, claim(s) is/are withdrawn from consideration.

5) ☐ Claim(s) is/are allowed.

6) ☐ Claim(s) is/are rejected.

7) ☐ Claim(s) is/are objected to.

8) ☒ Claims 1-49 are subject to restriction and/or election requirement.

## Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some\* c) ☐ None of:

- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

15) ☐ Notice of References Cited (PTO-892)

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No.(s): \_\_\_\_\_

18) ☐ Interview Summary (PTO-413) Paper No.(s): \_\_\_\_\_

19) ☐ Notice of Informal Patent Application (PTO-152)

20) ☐ Other:

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## DETAILED ACTION

### *Election/Restriction*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 17-26, 28-37, and 39-48, drawn to nucleic acids, classified in class 536, subclass 22.1.
  - II. Claims 27, 38, and 49, drawn to method of nucleic acid hybridization, classified in class 435, subclass 6.
2. The inventions are distinct, each from the other because of the following reasons:

Inventions of Groups I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the nucleic acids of Group I can be used in the method of hybridization of Group II or can be used to make RNA, and protein, and also can be used to make antisense nucleic acids for gene therapy.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. Claims 28, 29, and 38 are generic to a plurality of disclosed patentably distinct species comprising 9 different polymorphism. Moreover, claims 39-40, and 49 are generic to a plurality

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of disclosed patentably distinct species comprising 53 different polymorphism. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

5. A telephone call was made to Anita Meiklejohn on February 25, 2002, to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CAR 1.143).

#### *Conclusion*

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arun Chakrabarti, Ph.D. whose telephone number is (703) 306-5818. The examiner can normally be reached on 7:00 AM-4:30 PM from Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jones, can be reached on (703) 308-1152. The fax phone number

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for this Group is (703) 305-7401. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Arun Chakrabarti,

Patent Examiner,

February 26, 2002

*Arun K. Chakrabarti*  
**ARUN K. CHAKRABARTI**  
**PATENT EXAMINER**

# EXAMINER'S CASE ACTION WORKSHEET

Application No. <b>09/963,333</b>		Legal Instrument Examiner
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CHECK TYPE OF ACTION

DATE OF COUNT \_\_\_\_\_

<input type="checkbox"/> <b>Non-Final Rejection</b>	<input checked="" type="checkbox"/> <b>Restriction/ Election Only</b>	<input type="checkbox"/> <b>Final Rejection</b>
<input type="checkbox"/> <b>Ex Parte Quayle</b>	<input type="checkbox"/> <b>Allowance</b>	<input type="checkbox"/> <b>Advisory Action</b>
<input type="checkbox"/> <b>Examiner's Answer</b> <small>(Including Supplemental)</small>	<input type="checkbox"/> <b>Reply Brief Noted</b>	<input type="checkbox"/> <b>Non-Entry of Reply Brief</b>
<input type="checkbox"/> <b>Notice of Defective Appeal Brief</b>	<input type="checkbox"/> <b>Interference SPE</b> _____ <small>Approval for Disposal</small>	<input type="checkbox"/> <b>Suspension SPE</b> _____ <small>(Initial)</small>
<input type="checkbox"/> <b>Allowance After Examiner's Answer</b>	<input type="checkbox"/> <b>SIR Disposal</b> <small>(use only after FAOM)</small>	<input type="checkbox"/> <b>Post-Allowance Communication</b>
<input type="checkbox"/> <b>Miscellaneous Office Letter</b> <small>(With Shortened Statutory Period Set)</small>	<input type="checkbox"/> <b>Notice of Non-Responsive Amendment</b> <small>(With One Month Time Limit Set)</small>	<input type="checkbox"/> <b>Miscellaneous Office Letter</b> <small>(No Response Period Set)</small>
<input type="checkbox"/> <b>Letter Requiring Formal Drawings</b>	<input type="checkbox"/> <b>Supplemental Action</b>	<input type="checkbox"/> <b>Response to a Rule 312 Amendment</b>
<input type="checkbox"/> <b>Restart Time Period</b> <small>(e.g., Missing References)</small>	<input type="checkbox"/> <b>Interview Summary</b>	<input type="checkbox"/> <b>Authorization to Change Previous Office Action SPE</b> _____ <small>(Initial)</small>
<input type="checkbox"/> <b>Abandonment</b>	<input type="checkbox"/> <b>Express Abandonment</b> <small>Date: _____</small>	<input type="checkbox"/> <b>Abandonment After Examiner's Answer</b>

Examiner's Name: Arun Chakrabarti GAU: 1655